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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Christine Garcia

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466

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12/23/2008

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EXAMINER

SOROUGH, ALI

ART UNIT

PAPER NUMBER

1616

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/783,569	Applicant(s) GARCIA, CHRISTINE	
	Examiner ALI SOROUGH	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-38 is/are pending in the application.
- 4a) Of the above claim(s) 14, 19 and 32-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-13, 15-18, 20-31 and 38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgment of Receipt

Applicant's response filed 09/09/2008 to the Office Action mailed on 06/09/2008 is acknowledged.

Status of the Claims

Claim 10 is currently amended, claims 1-9 are cancelled, claims 14, 19, and 32-37 are currently withdrawn, and claim 38 is newly added. Therefore, claims 10-13, 15-18, 20-31, and 38 are currently pending examination for patentability.

Rejections and/or objections not reiterated from the previous Office Action are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set of rejections and/or objections presently being applied to the instant application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10-13, 15-18, and 20-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 provides for the utilization (use) of a composition as a slimming agent, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite

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where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Response to Applicants Arguments

Applicant argues that the amendment filed with the aforementioned response overcomes the rejection on the grounds of indefiniteness. Applicant's arguments have been fully considered and found not to be persuasive.

Applicant claims a method of using a composition without setting forth any active step and further without setting forth a clear method since it seems the preamble of the claim appears to be incomplete. The amendment "adding a composition having lipolytic activity to a formulation containing a cosmetically acceptable medium" and further "that reduces triglyceride content in adipocyte cells" makes it unclear if applicant is claiming a method of formulating a composition comprising the slimming agent represented by formula I or if applicant is claiming a method of reducing triglyceride content in adipocyte cells. If it is the latter is also unclear by what means this composition would be utilized to achieve the reducing triglyceride content in adipocyte cells effect. For the foregoing reasons the rejection of claims 10-13, 15-18, and 20-31 under 35 U.S.C. 112, second paragraph, **is maintained**.

Claim Rejections - 35 USC § 101

Claims 10-13, 15-18, and 20-31 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a

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proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Response to Applicants Arguments

Applicant argues that the amendment filed with the aforementioned response overcomes the rejection on the grounds of indefiniteness. Applicant's arguments have been fully considered and found not to be persuasive.

Applicant claims a method of using a composition without setting forth any active step and further without setting forth a clear method since it seems the preamble of the claim appears to be incomplete. The amendment "adding a composition having lipolytic activity to a formulation containing a cosmetically acceptable medium" and further "that reduces triglyceride content in adipocyte cells" makes it unclear if applicant is claiming a method of formulating a composition comprising the slimming agent represented by formula I or if applicant is claiming a method of reducing triglyceride content in adipocyte cells. If it is the latter is also unclear by what means this composition would be utilized to achieve the reducing triglyceride content in adipocyte cells effect. It appears that the preamble of the method is incomplete. For the foregoing reasons the rejection of claims 10-13, 15-18, and 20-31 under 35 U.S.C. 101 **is maintained**.

New Grounds of Rejection

Claim Rejections - 35 USC § 112

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10-13, 15-18, 20-31, and 38 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 and 38 recite " R_2 is one of". It is not clear what the metes and bounds of the group consists of. It is recommended that if applicant wishes to limit the group to those recited then the claim should read " R_2 is selected from".

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 16 recites a broader class of R_2 groups that claim 10 which claim 16 is dependent upon. Further,

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claim 17 recites broader class of R_2 groups that claim 10 which claim 17 is dependent upon through claim 16.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1. Claims 10-13, 15-18, 20-31, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stoltz (US Patent 6296859 B1, Published 10/02/2001).

Applicant Claims

Applicant claims a method of utilizing a composition that comprises as an active principle a mixture of compounds of formula (I): $R-CO-(NH-CH(R_1)-CO)_m-OH$. Applicant further claims a method of reducing triglyceride content in human adipocyte cells comprising administering the aforementioned composition.

Determination of the Scope and Content of the Prior Art (MPEP §2141.01)

Stoltz teaches, "Synergistic composition comprising a compound of lipoamino acid structure and a water lily extract". (See title). "One subject of the invention is a composition characterized in that it comprises as an active principle at least one compound of formula (I):" $R-CO-(NH-CH(R_1)-CO)_m-OH$ " or its topically acceptable salts, in which R represents the characterizing chain of a saturated or unsaturated, linear or branched fatty acid containing from 3 to 30 carbon atoms, R_1 represents the characterizing chain of an amino acid and m is between 1 and 5, and the constituents of at least one extract and/or of at least one tincture from plants of the Nymphaeaceae family." (See column 2, Lines 11-27). "The compound of formula (I) present in the composition which is subject of the present invention can be in free acid form or in partially or totally salified form." (See column 2, Lines 40-43). " R_1 represents in particular the characterizing chain of one of amino acids chosen from glycine, alanine, serine, aspartic acid, glutamic acid, valine, threonine, arginine, lysine, proline, leucine, phenylalanine, isoleucine, histidine, tyrosine, tryptophan, asparagine, cysteine, cystine, methionine, hydroxyproline, hydroxylysine, and ornithine." (See column 3, Lines 12-17). "One subject of the invention, is particularly, a cosmetic composition comprising, as active principle, from 0.001% to 6% by weight of at least one compound of formula(I) and from 0.0005% to 1% by weight of constituents of at least one extract (II) and /or of at least one tincture from a plant of the Nymphaeaceae family and, if desired, up to 1% of zinc gluconate." (See column 6, Lines 4-10). "Depending on the use, the composition as described above is used at different concentrations and in formulation which is suitable for this use; such cosmetic compositions are usually in the form of aqueous solutions,

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dilute alcoholic solutions, or simple or multiple emulsions ..." (See column 5, Lines 32-36). In preferred example a slimming gel is formed from a combination of the lipoamino acid, water lily extract, a thickener, ethanol, methanol, caffeine, extract of butchers broom, extract of ivy, a preserving agent, and water. (See column 16, example 26).

***Ascertainment of the Difference Between Scope the Prior Art and the Claims
(MPEP §2141.012)***

Stoltz does not anticipate using more than one lipoamino acid, however such a composition would have been obvious.

***Finding of Prima Facie Obviousness Rational and Motivation
(MPEP §2142-2143)***

It would have also been obvious to one of ordinary skill in the art at the time of the instant invention to utilize more than one lipoamino acid in the slimming composition taught by Stoltz. One would have been motivated to do so because Stoltz teaches that at least one and therefore multiple lipoamino acids maybe added to the compositions taught. With regard to the instantly claimed method of reducing triglyceride content in human adipocyte cells, it is the Examiners position that such activity would be implicit to the composition of Stoltz. Since the composition taught by Stoltz is used for slimming and applied topically, it would be expected that the lipoamino acid which is structurally indistinguishable from the instant compounds would also cause a reduction the amount of triglyceride content in human adipocyte cells. For the foregoing reasons the instant invention would have been obvious to one of ordinary skill in the art at the time of the instant invention.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ali Soroush whose telephone number is (571) 272-9925. The examiner can normally be reached on Monday through Thursday 8:30am to 5:00pm E.S.T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Johann Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent

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Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ali Soroush
Patent Examiner
Art Unit: 1616

/Mina Haghighatian/
Primary Examiner, Art Unit 1616